

### **REMARKS**

In response to the Office Action dated December 22, 2008, Applicants respectfully request reconsideration.

#### **Allowable Claims**

Applicants thank the Examiner for indicating that claims 1-9, 11-12, 14-18, 22-27, and 32 are allowable. Furthermore, Applicants thank the Examiner for also indicating that claims 29-31 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons set forth herein, Applicants respectfully assert that claim 28 is patentable as well.

#### **35 U.S.C. § 103 rejections**

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,482 (Elden) and separately, International Publication No. WO 01/26538 (Susstrunk).

Regarding the rejections made by the Examiner, Applicants respectfully assert that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103. The U.S. Code and the M.P.E.P. require that Examiners provide an explanation to support an obviousness rejection under 35 U.S.C. § 103 such that the applicant can be given fair opportunity to reply. *See* 35 U.S.C. § 132; M.P.E.P. §§ 706.02(j), 2141. Because the cited references do not suggest the claimed subject matter themselves, the Examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. *See* M.P.E.P. § 706.02(j). In the context of an Examiner finding a recited limitation is a “design choice,” the Examiner must explain why or how the cited reference, or the general knowledge in the art, makes the recited limitation a “design choice.” *See In re Gal*, 980 F.2d 717, 720 (Fed. Cir. 1992)(Noting that the Commissioner did not explain why or how the cited reference, or the general knowledge of the art, made a recited limitation obvious as a mere design choice.). In the context of claim 28, Applicants respectfully assert that the Examiner has not specifically articulated

why the shape or orientation of the electrode would have been a “mere matter of design choice.” Notwithstanding this, Applicants will attempt to respond to each of the Examiner’s rejections.

Neither Elden nor Susstrunk teaches, discloses, suggests, or makes obvious a device, as recited in claim 28, that includes an elongate first electrode and a band for fixing the first electrode to at least one of an arm and a leg of a body with a longitudinal axis of the first electrode being substantially parallel to the at least one arm and leg. The Examiner agrees that neither Elden nor Susstrunk teaches the shape of the electrode as recited in claim 28. The Examiner asserted, however, that the exact shape of the electrodes would have been a “mere matter of design choice” for one skilled in the art. Applicants respectfully assert that it would not have been a “mere matter of design choice” to modify either of Elden or Susstrunk to arrive at claim 28. Indeed, the shape and orientation of the electrode recited in claim 28 was chosen for at least one specific reason, and was not a random design choice.

With regard to Elden, the Examiner states that Elden discloses a wristwatch device for measuring glucose that includes two electrodes. Elden fails to disclose, however, any teaching or suggestion that would lead a person of ordinary skill to modify the discussed configuration to arrive at the elongate electrode recited in claim 28. Elden merely discusses a pair of spaced apart electrodes. Elden does not, however, discuss any reasons to i) vary the shape of either of the pair of electrodes, or ii) vary the orientation of the pair of electrodes such that a longitudinal axis of one of the electrodes extends parallel to the arm/leg that the electrode is fixed to. Furthermore, the portion of Elden cited by the Examiner actually *teaches away* from the subject matter recited in claim 28. *See* col. 10, ll. 12-13 (“Such an embodiment might not prove to be useful for all subjects.”)

With regard to Susstrunk, the Examiner states that Susstrunk discloses a wristwatch device for measuring glucose that has an electrode that is placed near the skin. Susstrunk discusses a coil that is brought within range of the body surface. Susstrunk, p. 2, ll. 22-23. A measuring value depending on the inductance or loss of the coil is measured, and the desired concentration of a component is determined by means of a suited calibration function. *Id.* at ll. 23-25. The coil L is cylindrical, and has an axis

being perpendicular to the body surface. *Id.* at p. 4, ll. 4-7. Susstrunk fails to disclose, however, any teaching or suggestion that would lead a person of ordinary skill to modify the discussed configuration to arrive at the elongate electrode recited in claim 28. First, Susstrunk does not discuss any electrodes that are held against the body (i.e., the coil L discussed in Susstrunk is not an electrode). Second, *even if* it is assumed that the coil L of Susstrunk is an electrode, Susstrunk still does not discuss any reasons to i) vary the shape of the coil from the discussed cylindrical configuration, or ii) vary the orientation of the coil from being perpendicular to the body surface.

Lastly, with regard to each of Elden and Susstrunk, the present disclosure itself counters the assertion that the shape of the electrode is a “mere matter of design choice” that would have been obvious to a person of ordinary skill. Indeed, the shape and orientation of the electrode recited in claim 28 were specifically chosen to overcome technical disadvantages. *See In re Chu*, 66 F.3d 292 (Fed. Cir. 1995) (Finding that a claimed feature was not “merely a design choice” when notable technical reasons existed for the configuration of the claimed feature.) For example, page 2, lines 27-35 of the present specification discusses that the elongate shape of the electrode provides a large interaction space that allows a higher level of accuracy in the resulting measurement. A round electrode, or an elongate electrode extending perpendicularly to the arm/leg would not have such a large (and homogeneous) interaction volume with the arm/leg tissue. *See also* page 6, lines 19-23; page 7, line 32 – page 8, line 7; page 8, line 19-20.

Thus, for at least the above reasons, claim 28 is patentable over each of Elden and Susstrunk.

Claims 29-31 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten into independent form including all of the limitations of the base claim and any intervening claims. For at least the reasons discussed above, Applicants believe that claim 28 is patentable, and thus, that claims 29-31 are also patentable as currently recited.

### **Conclusion**

Based on the foregoing, this application is believed to be in allowable condition, and a notice to that effect is respectfully requested. If a telephone conversation with

Applicant's representative would help expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at (617) 542-6000.

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account 50-0311, Reference No. 24334-001. The Director is further authorized to charge any required fee(s) under 37 C.F.R. §§ 1.19, 1.20, and 1.21 to the abovementioned Deposit Account.

Respectfully submitted,

/Kyle Turley/

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